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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,639	07/28/2003	Michael J. Simons	84546CPK	4913

7590 05/03/2005

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EXAMINER

SHAH, MANISH S

ART UNIT	PAPER NUMBER
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2853

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/628,639

Applicant(s)

SIMONS ET AL.

Examiner

Manish S. Shah

Art Unit

2853

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-4, 6, 11 & 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 7, 10 & 12 of U.S. Patent No. 6,131,514 in view of Kanou et al. (# EP 0803554 A2).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is disclosed in the US Patent and is covered by the US Patent, except that the aqueous solution or aqueous colloidal dispersion of polymer includes pigment particle therein.

However, the Kanou et al. reference teaches that to get the waterproof and high quality printed image, the composition includes the aqueous solution or aqueous colloidal dispersion of polymer includes pigment particle therein (page: 2, line: 12-15; page: 5, line: 35-40).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the composition of US Patent # 6131514 by the aforementioned teaching of Kanou et al. in order to have a waterproof and high quality printed image.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 14-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Kanou et al. (# EP 0803554 A2).

Kanou et al. teaches that to get the high quality waterproof printed image, the composition includes the aqueous solution or aqueous colloidal dispersion of polymer includes pigment particle therein (page: 2, line: 12-15; page: 5, line: 35-40), wherein the pigment is selected from azo, carbon black with the particle size of 0.01 micron to 5 micron (10 to 5000 nm) (page: 5, line: 40-45), and pigment is present in an amount from 1 to 20% by weight (see Examples). They also disclose that the water solubilising group is ionisable acid group, which is selected from carboxylic and sulfonic acid (see Examples). They also teach that the polymer is selected from polyester in the range from 0.02 to 8% by wt. (see Examples); and pigment from 0.1 to 10% by wt. (see Examples).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simons (# US 6131514) in view of Kanou et al. (# EP 0803554 A2).

Simons discloses a method of preparing a printing plate including inkjet printing an oleophilic image on a surface of a support by applying to the support an aqueous solution or aqueous colloidal dispersion of a polymer having water-solubilising groups, wherein the water-solubilising groups interact with the support surface, thereby binding the polymer to the support surface and rendering the polymer insoluble (column: 1, line: 45-55); wherein the water solubilising groups are ionisable acid group, which is selected from the group consisting of carboxylic acid and sulfonic acid groups (column: 2, line: 15-24). They also disclose that the polymer is selected from polyester or sulfonated polyester and polymer prepared by polymerization of ethylenically unsaturated monomers (column: 2, line: 45-55; column: 6, line: 15-20). They also disclose that the polymer is present in an aqueous solution or aqueous colloidal dispersion in the range 0.02 to 5% by weight (column: 6, line: 25-30). They also disclose that the support is selected from metallic surface or polymeric sheet or foil, and more preferably support is

metallic and has an oxidized surface (column: 2, line: 25-35). They also disclose that the support is coated with hydrophilic layer of a polymer (column: 2, line: 25-30).

Simons differs from the claim of the present invention in that (1) the aqueous solution or aqueous colloidal dispersion of polymer includes pigment particle therein. (2) The pigment is selected from carbon black, C.I. Pigment Red 122 with the particle size of 10 to 100 nm, and pigment is present in an amount from 0.1 to 10% by weight.

Kanou et al. teaches that to get the high quality waterproof printed image, the composition includes the aqueous solution or aqueous colloidal dispersion of polymer includes pigment particle therein (page: 2, line: 12-15; page: 5, line: 35-40), wherein the pigment is selected from azo, carbon black with the particle size of 0.01 micron to 5 micron (10 to 5000 nm) (page: 5, line: 40-45), and pigment is present in an amount from 1 to 20% by weight (see Examples).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the composition of Simons by the aforementioned teaching of Kanou et al. in order to have a high quality waterproof printed image.

Conclusion

5. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 07/28/03 & 01/29/04 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manish S. Shah whose telephone number is (571) 272-2152. The examiner can normally be reached on 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2853

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Manish S. Shah
Primary Examiner
Art Unit 2853



MSS

4/26/05